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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

AVELLINO, JOSEPH E

ART UNIT PAPER NUMBER

2143

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,818

Applicant(s)

WILEY ET AL.

Examiner

Joseph E. Avellino

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/5/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-24 are presented for examination; claims 1, 14, and 20 independent.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-6, 8, 13-16, and 20-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Lopresti et al. (USPN 5,754,308) (hereinafter Lopresti).

3. Referring to independent claims 1, 14, and 20, (e.g. exemplary claim 1), Lopresti discloses a method for providing a remote document history repository (e.g. online document database), comprising:

 sending a document from a multifunction device (an inherent feature since the document must get from the input device to the archive server) (col. 8, lines 1-34); and

 recording delivery data for said sent document in said remote document history repository (i.e. archive server) when said document is sent from said multifunction device (see above), wherein said delivery data is accessible from said remote document history repository independent of said multifunction device (i.e. accessible by numerous input and output devices on the network) (Figure 4; col. 6, lines 20-34; col. 7, line 56 to col. 8, line 34).

4. Referring to claim 2, Lopresti discloses accessing said remote document history repository to track document flow (col. 8, lines 14-34).
5. Referring to claim 3, Lopresti discloses sending the document is from a network digital copier (col. 3, line 66 to col. 13; col. 6, lines 20-34).
6. Referring to claim 4, Lopresti discloses updating said remote document history repository to indicate receipt of said sent document (e.g. storing the digital representation) (col. 8, lines 30-34).
7. Referring to claim 5, Lopresti discloses copying said document to said remote document history repository (col. 8, lines 30-34).
8. Referring to claim 6, Lopresti discloses resending said document by sending said copied document from said remote document history repository (col. 1, lines 58-67).
9. Referring to claim 8, Lopresti discloses copying said document to a network site (e.g. archive server) (col. 8, lines 1-34).
10. Referring to claim 13, Lopresti discloses converting a paper document to an electronic document at a multifunction device fro sending therefrom (col. 7, line 35 to col. 8, line 34).

11. Claims 15, 16, and 21-24 are rejected for similar reasons as stated above.

Claim Rejections - 35 USC § 103

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 9, 11, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopresti in view of Serbinis et al. (USPN 6,584,466) (hereinafter Serbinis).

13. Referring to claims 9 and 17, Lopresti discloses the invention substantively as described in claim 8. Lopresti does not specifically state notifying an intended recipient of said document that said copied document is available from said network site. In analogous art, Serbinis discloses another document archival system which notifies an intended recipient of said document that said copied document is available from said network site (col. 10, lines 35-44). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Serbinis with Lopresti since Lopresti discloses numerous methods of archiving and storing electronic documents however is relatively silent on methods of searching and retrieving these documents from the archive server, which is well known in the art to be necessary in order for the system to be beneficial for the repository. This would lead one of ordinary

skill in the art to search for other methods of querying the repository and retrieving documents from the archive server, eventually finding Serbinis and its novel method of accessing the document archival system via previously known web browsers over the Internet and presenting end-users with distinct dedicated websites (e.g. abstract).

14. Referring to claims 11 and 19, Lopresti discloses the invention substantively as described in claim 1. Lopresti further discloses monitoring receipt of said electronic document (see above). Lopresti does not specifically disclose resending said electronic document after a predetermined time based on said delivery data recorded in said remote document history repository. In analogous art, Serbinis discloses another document archival system which resends said electronic document after a predetermined time based on said delivery data recorded in said remote document history repository (the office takes the term "predetermined time" to be construed as, "a predetermined event", such as the receipt of a notification email and the establishment of a user session by the recipient) (col. 10, lines 35-54; col. 18, line 22 to col. 19, line 30). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Serbinis with Lopresti since Lopresti discloses numerous methods of archiving and storing electronic documents however is relatively silent on methods of searching and retrieving these documents from the archive server, which is well known in the art to be necessary in order for the system to be beneficial for the repository. This would lead one of ordinary skill in the art to search for other methods of querying the repository and retrieving documents from the archive server,

eventually finding Serbinis and its novel method of accessing the document archival system via previously known web browsers over the Internet and presenting end-users with distinct dedicated websites (e.g. abstract).

Claims 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopresti in view of Cullen et al. (USPN 5,893,908) (hereinafter Cullen).

15. Referring to claim 10, Lopresti discloses the invention substantively as described in claim 1. Lopresti does not specifically state that the system notifies the user if the document is undeliverable. In analogous art, Cullen discloses another document archival system which notifies the user when a document already exists within a database (i.e. is undeliverable since there exists a copy of the document in the database already) (e.g. abstract). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Cullen with Lopresti since Lopresti discloses numerous methods of archiving and storing electronic documents however is relatively silent on methods of searching and retrieving these documents from the archive server, which is well known in the art to be necessary in order for the system to be beneficial for the repository. This would lead one of ordinary skill in the art to search for other methods of querying the repository and retrieving documents from the archive server, eventually finding Cullen and its novel method of querying the database with search keys (col. 5, line 55 to col. 6, line 45).

16. Claim 18 is rejected for similar reasons as stated above.

Claims 7 and 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lopresti in view of Hull et al. (USPN 5,978,477).

17. Referring to claim 7, Lopresti discloses the invention substantively as described in claim 5. Lopresti does not specifically disclose redirecting the document by sending the copied document from the repository to another recipient. In analogous art, Hull discloses another document archival system wherein the document is redirected sending the copied document from the repository to another recipient (col. 6, lines 15-40). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Hull with Lopresti to further simplify the user interface of Lopresti which requires the user to determine numerous selections (i.e. Photocopy or Electronic mode, Paper and Electronic or Print and Archive output) whereby the user interface of Hull will automatically enable the user to automatically archive the document efficiently as stated in Hull (col. 1, lines 22-31).

18. Referring to claim 12, Lopresti discloses the invention substantively as described in claim 1. Lopresti does not specifically disclose the recording said delivery data is transparent to a user of the device. In analogous art, Hull discloses another document archival system wherein the recording of delivery data is transparent to the user (e.g. abstract). It would be obvious to a person of ordinary skill in the art at the time the

invention was made to combine the teaching of Hull with Lopresti to further simplify the user interface of Lopresti which requires the user to determine numerous selections (i.e. Photocopy or Electronic mode, Paper and Electronic or Print and Archive output) whereby the user interface of Hull will automatically enable the user to automatically archive the document efficiently as stated in Hull (col. 1, lines 22-31).

Claim Rejections - 35 USC § 102

Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Cullen et al. (GB 2331383) (hereinafter Cullen) (cited by Applicant in IDS dated April 5, 2005, and as such pursuant to MPEP 609(B)(2)(i) is proper to be cited in a new ground of rejection in a final rejection).

19. Referring to claim 1, Cullen discloses a method for providing a remote document history repository (e.g. image storage system 100), comprising:

 sending a document from a multifunction device (p. 8, lines 8-10; p. 15, lines 21-23); and

 recording delivery data for said sent document in said remote document history repository (i.e. e.g. remote storage facility, AKA RSF 360) when said document is sent from said multifunction device, wherein said delivery data is accessible from said remote document history repository independent of said multifunction device (i.e. accessible by numerous input and output devices on the network) (p. 14, lines 15-23; p. 17, lines 5-20).

20. Referring to claim 2, Cullen discloses accessing said remote document history repository to track document flow (i.e. where document is stored either on the multifunction device or the RSF) (p. 17, line 20 to p. 18, line 4).

21. Referring to claim 3, Cullen discloses sending the document is from a network digital copier (Figure 1, ref. 130; p. 8, lines 8-10).

22. Referring to claim 4, Cullen discloses updating said remote document history repository to indicate receipt of said sent document (e.g. timestamps) (p. 14, lines 15-22).

23. Referring to claim 5, Cullen discloses copying said document to said remote document history repository (p. 15, lines 21-23).

24. Referring to claim 6, Cullen discloses resending said document by sending said copied document from said remote document history repository (p. 17, lines 11-12).

25. Referring to claim 8, Cullen discloses copying said document to a network site (e.g. RSF 360) (p. 15, lines 21-23).

26. Referring to claim 9, Cullen discloses notifying an intended recipient of said document that said copied document is available from said network site (i.e. RSF) (Figure 6; p. 17, lines 5-18).

27. Referring to claim 10, this is an inherent feature of the system, since if data has not been acknowledged it will timeout and will be determined to be undeliverable.

28. Referring to claim 11, Cullen discloses monitoring receipt of document and resending document after a predetermined time based on delivery data (i.e. transmit data to RSF at predetermined intervals) (p. 16, lines 11-15).

29. Referring to claim 12, Cullen discloses recording the delivery data is transparent to a user of said multifunction machine (i.e. every time a document is copied faxed or printed) (p. 9, lines 5-15).

30. Referring to claim 13, Cullen discloses converting a paper document to an electronic document at a multifunction device for sending therefrom (an inherent feature when a document is transmitted from a digital copier) (p. 8, lines 8-10).

31. Claims 14-24 are rejected for similar reasons as stated above.

Response to Arguments

32. Applicant's arguments filed April 5, 2005 have been fully considered but they are not persuasive.

33. In the remarks, Applicant argues, in substance, that (1) Lopresti does not disclose sending a document from a multifunction device and then recording delivery data for the sent document, (2) Lopresti does not disclose accessing a remote document history to track document flow, (3) Lopresti does not disclose updating a remote document history repository to indicate receipt of sent document, (4) Lopresti does not disclose resending the document to the archive server.

34. As to point (1) Applicant's attention is directed to col. 8, lines 10-13 of Lopresti. It is stated that "the copier...then effects printing of the page...*and simultaneously transmits a digital representation of the page to the archive server.* Furthermore Lopresti discloses at col. 8, lines 30-35 that "the archive server *stores the digital representation of each page according to its DocID and provides storage management...relative to the pages*". The DocID is the delivery data, since it governs how the document is stored in the archive server. By this rationale, the rejection is maintained.

35. As to point (2), Applicant is using broad terms such as "track document flow" to define the invention, and as such the Office interprets this term broadly. The term can

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be construed as to track how the documents are stored in the server, which is what "storage management, document management, security, and accounting functions relative to the pages" (col. 8, lines 30-35) comprises. Although, it does not specifically utilize the same wording as the claimed invention, the functionality is exactly the same. They both provide managing the documents.

36. As to point (3) Applicant is invited to the cited passage of claim 4. The archive server stores the digital representation according to its DocID. This is an inherent feature of the invention since if it is stored according to the DocID, and storage is allocated in the archive server for the digital representation, then the reception must indicate that the storage space has been filled. By this rationale, the rejection is maintained.

37. As to point (4) Applicant's attention is directed to col. 6, lines 30-31, where it is stated that the archive server transmits "the digital representation of the page is provided from the server to the copier". Therefore the server transmits the document (which has already been transmitted to the server, hence resending) to the copier and then prints the document. By this rationale, the rejection is maintained.

Conclusion

38. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on April 5, 2004 prompted the new

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ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

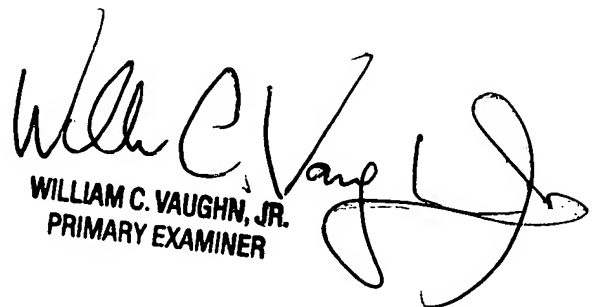
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JEA
April 21, 2005


WILLIAM C. VAUGHN, JR.
PRIMARY EXAMINER